



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. Of: Christian, *et al.*
Serial No.: 09/776,318
Filed: February 2, 2001
For: Compression Journal
Group Art Unit: 2834
Examiner: Thanh Lam

DOCKET: DIAMOND.1002

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE AND AMENDMENT

This amendment is being filed in response to the Final Office Action mailed January 17, 2006. In response thereto, please enter the following amendment and consider the following remarks.

AUTHORIZATION TO DEBIT ACCOUNT

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this response. However, in the event that additional extensions of time are necessary to allow consideration of this response, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a) and any fee required therefore (including fees for net addition of claims) are hereby authorized to be charged to deposit account No. 08-1391.

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Serial No. 09/776,318

REMARKS

This is a full and timely response to the outstanding final Office Action mailed January 17, 2006. Claims 1-17 are preliminarily rejected under 35 USC§103(a) as being unpatentable. The Applicants traverse the rejections to claims 1-17. Reconsideration and allowance of the subject application and presently pending claims 1-17 is respectfully requested.

II. Response To Claim Rejections Based On Obviousness

In the Office Action, claims 1-17 are preliminarily rejected under 35 USC 103(a) as being unpatentable over prior art in view of US Patent No. 4,233,580 to Treczka, et al. (hereinafter "Treczka"). There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. See, e.g., In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). If the combination of the references teach every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious is improper. The level of skill in the art cannot be relied upon to provide the suggestion to combine references. Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

A. Claim 1

1. A compression journal comprising:
at least two circularly shaped segments;
a cylindrical shaft having said circularly shaped segments positioned around said shaft;

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